



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/807,866

03/23/2004

Ted M. Dean

T32123US

5509

28805 7590 05/04/2009
ARNOLD & KNOBLOCH, L.L.P.
2401 FOUNTAIN VIEW DRIVE
SUITE 630
HOUSTON, TX 77057

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/807,866	Applicant(s) DEAN ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/22/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments in the response dated April 22, 2009.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2 and 4 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Repaci et al. (USPN 6,109,852) in view of Miles (USPN 6,383,591).

Repaci et al. disclose a merchandising strip (Figures 1 and 2, #10) for displaying a plurality of discrete packages (Column 6, lines 22 - 38), comprising: an elongated, narrow strip of plastic capable of supporting a plurality of discrete packages (Figures 1 and 2, #12; Column 6, lines 22 - 38) said strip of plastic (Column 5, lines 23 – 27) having a plurality of edges along a longitudinal axis (Figure 1, #10), said strip of plastic having a first side and a second side (Figure 4), and a plurality pre-shaped of adhesive elements (Figure 3), said plurality of adhesive elements having an adhesive substance (Figure 1, #20 – 25), each adhesive element capable of

Art Unit: 1794

removably adhering to a discrete package of the plurality of discrete packages (Column 7, lines 31 - 34), said plurality of adhesive elements laminated on top of the surface (Figure 1, #20 - 25) said second side of said strip of plastic (Figure 1, #20 - 25), whereby the edges of said adhesive element are exposed above the surface of said second side (Figures 3 and 3; #20, 22 and 23) as in claim 1. For claim 2, the strip of plastic is clear plastic (Column 5, lines 24 - 27). As in claims 6 and 7, the adhesive elements have a rectangular or square configuration (Figure 1, #20 - 25).

With regard to claim 12, said strip has first and second ends and has a hole near one end of said strip, to allow said strip to be hung vertically for display (Column 7, lines 28 - 34). However, Rodriguez fails to disclose said first side being coated, wherein the coating of said first coated side is substantially non-adhesive to said plurality of adhesive elements, whereby ease in rolling and unrolling said plastic strip along the longitudinal axis is enabled by said coated side and adhesive element combination, said coating on said first side is comprised of silicone, said adhesive elements each have a circular, triangular, pentagonal, oval or star configurations and said strip has first and second ends and has first and second holes, one such hole being near each end of said strip, to allow said strip to be hung vertically for display without regard to the orientation of any such packages attached to said adhesive elements.

Miles teaches a strip (10) comprising an elongated, narrow strip (14) of transparent plastic (col. 13, lines 15-18) having a first coated side (col. 6, lines 42-48), the coating on said first side covering the entire surface of such first side (because the patent does particularly specify that it is partially coated as arguably admitted by the applicant is the Appeal Brief of 10/2/2007, page-5, lines 17-18), and a second uncoated side (figure-2 showing the side with the

Art Unit: 1794

adhesive (26)), whereby said coated side is coated with silicone (Column 6, lines 42 – 48) that allows said strip to be easily rolled up and unrolled from a roll (col. 6, lines 42-48) and the strip has first and second holes, one such hole being near each end of said strip (such as perforation as recited in col. 12, lines 32-33 which includes a hole at each end of the line of perforations) for the purpose of facilitating the unwinding of the sheeting from a roll (Column 6, lines 45 – 46).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the first side coated with silicone in Rodriguez in order to facilitate the unwinding of the sheeting from a roll as taught by Miles.

Repaci et al., as discussed above, fails to teach that the adhesive elements configuration is circular, triangular, pentagonal, oval, or star. It would have been an obvious matter of design choice to modify Repaci et al adhesive pattern such that each of the adhesive elements having the dot shape is modified to have a circular, triangular, pentagonal, oval or star configuration to provide for a discontinuous pattern for controlling the adhesiveness, and such a change in shape would have obvious to one having ordinary skill in the art. MPEP 2144.04 (IV).

With regard to the limitation of “one such hole being near each end of said strip, to allow said strip to be hung vertically for display without regard to the orientation of any such packages attached to said adhesive elements”, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second hole at the second end of the strip,

Art Unit: 1794

since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. MPEP 2144.04 (VI).

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Repaci et al. (USPN 6,109,852) in view of Miles (USPN 6,383,591) as applied to claims 1, 2 and 4 – 13 above, and further in view of Miller et al. (USPN 6,840,391).

Repaci et al., as modified with Miles, discloses the claimed invention except for the plastic being positioned and arranged into a rolled state along the longitudinal axis of the plastic strip.

Miller et al. teaches a plurality of display strips (Figure 1, #20) being positioned and arranged into a rolled state (Figure 2) for the purpose of dispensing the display strips (Column 3, lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the rolled strips in Repaci et al. in order to dispense the display strips as taught by Miller et al.

With regard to the limitation of “along the longitudinal axis of the plastic strip”, it would have been obvious to one of ordinary skill in the direction of how the strips are rolled in order how to change how the strips are dispensed.

Affidavit under 37 CFR 1.132

5. The affidavit under 37 CFR 1.132 filed April 22, 2009 is insufficient to overcome the rejection of claims 1, 2, 4 - 13, 22 and 23 based upon the rejection as set forth in the last Office action because: It include(s) statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. There is no clear evidence, or data, to show that is cheaper or easier to produce the claimed invention over the prior art inventions.

6. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2 and 4 – 13 have been considered but are moot in view of the new ground(s) of rejection.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Art Unit: 1794

In this case, there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art since Miles shows that a second uncoated side (figure-2 showing the side with the adhesive (26)), whereby said coated side is coated with silicone (Column 6, lines 42 – 48) that allows said strip to be easily rolled up and unrolled from a roll (col. 6, lines 42-48) and the strip has first and second holes, one such hole being near each end of said strip (such as perforation as recited in col. 12, lines 32-33 which includes a hole at each end of the line of perforations) for the purpose of facilitating the unwinding of the sheeting from a roll (Column 6, lines 45 – 46).

9. In response to applicant's argument that Miles is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Miles is reasonably pertinent to the particular problem with which the applicant was concerned, the ability to easily roll up and unroll strips (col. 6, lines 42-48).

With regard to the adhesive coating on the strip and the use of a single plastic strip, please see the rejection in view of Repaci et al.

Allowable Subject Matter

10. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

Art Unit: 1794

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794